



02 FEB 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Striker Striker & Stenby
103 East Neck Road
Huntington NY 11743

In re Application of	:	
HOFMANN et al.	:	DECISION
Application No.: 10/564,669	:	
PCT No.: PCT/EP2004/052875	:	
Int. Filing Date: 08 November 2004	:	
Priority Date: 20 December 2003	:	
Attorney's Docket No.: 3474	:	
For: INSERTION TOOL FOR A MACHINE TOOL	:	

This is a decision on the submission filed by applicants on 17 November 2008, which has properly been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 08 November 2004, applicants filed international application PCT/EP2004/052875 which designated the U.S. and claimed a priority date of 20 December 2003. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 07 July 2005. The thirty-month period for paying the basic national fee in the United States expires at midnight on 20 June 2006.

On 13 January 2006, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the Basic National Fee and three declarations of inventors. The indication in the declaration that inventor Markus HECKMANN is deceased has been treated as a request for status under 37 CFR 1.42.

On 24 April 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AN 37 CFR 1.495 (Form PCT/DO/EO/903) according the application a 35 U.S.C. § 371(c)(1), (c)(2), and (c)(4) date of 13 January 2006 and a 35 U.S.C. 371 date of 13 January 2006.

On 04 April 2008, a decision was mailed refusing applicants' request for status under 37 CFR 1.42 because the declarations did not include the residence, mailing address and citizenship of the person(s) signing on behalf of the deceased inventor (37 CFR 1.497(b)(2)) in addition to

the *full name and citizenship of the deceased inventor* (37 CFR 1.497(a)(3)). The decision also noted

(1) that the declarations of inventors filed 13 January 2006 were not in compliance with 37 CFR 1.497(a)-(b) because they did not list the inventorship set forth in the international application (The declarations identify two additional inventors (Christof Hoelzl and Johan Huber) compared to the international application.),

(2) the declarations filed 13 January 2006 were not sufficient because each contained non-initialed alterations (page 2 of each declaration),

(3) the declaration of inventors signed by Albrecht Hofmann, Harald Krondorfer, Thomas Schomisch, and Christof Hoelzl was not in compliance with 37 CFR 1.497(a)-(b) because it did not list Markus Heckmann's citizenship in addition to the residence, mailing address and citizenship of the person(s) signing on behalf of the deceased inventor (37 CFR 1.497(b)(2)). (The third page of this declaration is missing.), and

(4) the three declarations of inventors filed 13 January 2006 were not in compliance with 37 CFR 1.497(a)-(b) because none of them were executed by the legal representative.

The decision also vacated the NOTIFICATION OF ACCEPTANCE mailed 24 April 2006.

Finally, the decision set a two-month extendable time period for response.

On 30 July 2008, a Notice of Abandonment was mailed indicating that the application was abandoned for failure to timely file a proper reply to the Office letter mailed on 04 April 2008.

On 17 November 2008, applicants filed the instant petition, which has properly been treated as a petition under 37 CFR 1.181.

DISCUSSION

The instant petition requests that the that the application be reinstated. The Notice of Abandonment mailed 30 July 2008 was issued before the application became abandoned and is hereby VACATED. Nevertheless, the application is now abandoned for failure to timely file a proper reply to the Office letter mailed on 04 April 2008. Accordingly, the application is not reinstated.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

For the reasons set forth above, the application is **ABANDONED**.

For the reasons set forth above, the Notice of Abandonment mailed 30 July 2008 is VACATED.

Applicants may wish to consider filing a petition under 37 CFR 1.137 to revive the application.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for preparation and mailing of a NOTIFICATION OF ABANDONMENT.

/Daniel Stemmer/

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459